UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,117	01/08/2002	Donald F. DePalma	CRD0918	4482

27777 7590 10/28/2005

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER	
MILLER, CHERYL L	
ART UNIT	**PAPER NUMBER**
3738	

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/041,117
Filing Date: January 08, 2002
Appellant(s): DEPALMA ET AL.

Carl J. Evens (Registration No.33,874)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 27, 2005 appealing from the Office action mailed March 29, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

Claim 20 contain(s) substantial errors as presented in the Appendix to the brief. That is, claim 20 is missing in the listing of claims in the brief appendix. Accordingly, claim 20 is correctly written in the Appendix to the Examiner's Answer.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 21, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Rhodes (US 5,843,160, previously cited). Referring to claim 1, Rhodes discloses a system for bypassing an aneurysm comprising a first prosthesis (20A), defining a single flow conduit and having a proximal end (top) and a distal end (bottom), the conduit comprising a stent structure (26, 28) and a graft (22) covering the stent structure, the graft having longitudinally oriented pleats (col.8, lines 6-15), and a compressible gasket (90s; see fig.6) positioned within the distal end of the first prosthesis (gasket 90s, attached to second prostheses initially is maneuvered through the distal end of the first prosthesis and expanded, col.4, lines 38-47; it is capable of being placed anywhere along the first prosthesis, including the distal end), the gasket having at least two apertures therein (fig.6), and at least two bypass prostheses (20B, 20C) in fluid communication with the distal end of the first prosthesis (20A) through the apertures (fig.6), the compressible gasket (90s) being configured to provide a seal between the first prosthesis and the two second prostheses.

Referring to claim 6, Rhodes discloses the second prostheses (20B, 20C) comprising a stent (34, 36, 38) and a graft material (32) communicating with the stent.

Referring to claim 21, Rhodes discloses a gasket (90s) substantially impervious to fluid, creating a seal between the first (20A) and second prostheses (20B, 20C).

Referring to claim 24, Rhodes discloses a first prosthesis (20A) of sufficient length to extend form a healthy region of a neck into an aneurysm and a gasket (90s) engaged with the second prostheses (20B, 20C) at a position along the first prosthesis (20A) adapted to be disposed within an aneurysm (see figures).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhodes (US 5,843,160, previously cited) in view of the applicants specification. Rhodes discloses a system having a compressible gasket (90s) to provide a seal between two prostheses. Rhodes however discloses the gasket to be made of a mesh instead of a foam (col.9, lines 41-52; col.10, lines 26-35). The applicant admits in their specification on page 21, P[0091], that open cell foams are well known materials for use with gaskets, to those of ordinary skill in the art, and obvious equivalents to the woven or knitted meshes such as the ones disclosed by Rhodes. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an open cell foam for the gasket material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 1, 6, 20, 21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dereume et al. (US 6,554,858 B2, previously cited) in view of Lunn (US 5,476,506, cited by applicant in IDS). Referring to claim 1, Dereume discloses a system for bypassing an aneurysm comprising a first prosthesis (1), defining a single flow channel conduit (fig.1 at cross section II and IV), having a proximal end (top of fig.1, 5) and a distal end (bottom of fig.1, 5), the conduit comprising a stent structure (3) and a graft material (covering 12 or 11+12; see fig.5-8) covering the stent structure, a compressible gasket (portions 5, 6 of sleeve 4 seen in fig.7; or partition seen in fig.10, 12, and 17) positioned within the distal end of the first prosthesis (Dereume has shown the gasket 5, 6 and partition to be positioned across the bottom extent of the first prosthesis, therefore is positioned within the distal end; also, Dereume also discloses that the gasket 5, 6 may extend across a further extent of the first prosthesis, col.5, lines 63-65, therefore, inherently it may extend across the distal end of the first prosthesis), the gasket having at least two apertures (7, 8), and at least two bypass prostheses (13) in fluid communication with the first prosthesis (1) by the distal end (see figs), the two bypass prostheses having proximal and distal ends, the compressible gasket being configured to provide a seal between the first prosthesis and the two bypass prostheses. Dereume discloses a system substantially as claimed. Dereume does not however, disclose the first prosthesis graft to have pleats. Lunn teaches in the same field of aneurysm bypassing systems, a prosthesis having a stent and a graft covering the stent to have longitudinally oriented pleats, in order to provide the prosthesis with increases radial flexibility, allowing the graft to expand further. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Dereume's aneurysm bypassing system

with stent and graft, with Lunn's teaching of placing longitudinal pleats on the graft of aneurysm bypassing systems, in order to provide the prosthesis with increases radial flexibility, allowing the graft to expand further.

Referring to claim 6, Dereume discloses the second prostheses (13) comprising a stent (14) and a graft material (15) communicating with the stent.

Referring to claim 21, Dereume discloses a gasket (5, 6 or partition) substantially impervious to fluid, creating a seal between the first and second prostheses (col.5, lines 39-44; fig.7).

Referring to claim 24, Dereume discloses a first prosthesis (1) of sufficient length (see figures) to extend form a healthy region of a neck into an aneurysm and a gasket (5, 6) engaged with the bypass prostheses (13) at a position along the first prosthesis adapted to be disposed within an aneurysm.

Referring to claim 20, Dereume in view of Lunn discloses a system for bypassing an aneurysm comprising a compressible gasket for sealing a first prosthesis to a second prosthesis. Dereume in view of Lunn disclose the gasket (4, 5, 6; or partition) to be made of a graft material or other materials used for sealing 9col.4, lines 1-6; col.6, lines 53-61), however are not specific to disclose an open cell foam material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the gasket out of open cell foam material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

(10) Response to Argument

Response to argument 1. The appellant has argued on page 4 of the brief, that "In Rhodes, stents are only utilized on the ends of the sleeves and not throughout the entire length of the component." While this may be true, the appellant has not claimed a stent to extend throughout an entire length of a sleeve. The appellant has only claimed a conduit including a self-expanding lattice and graft material covering at least a portion of the lattice. Nowhere in the claim is it required for the stent in combination with the graft to extend the entire length of the conduit (sleeve as appellant has referred to it in the arguments).

Response to argument 2. It is first noted, that the 103 rejection was made over claim 20, not claim 21 as indicated in the arguments section of the brief. The appellant has argued that the 103 rejection of Rhodes is without merit for reasons that Rhodes contains deficiencies in the independent claim 1 that carry over to dependent claim 20. This argument has already been addressed above in response to argument 1.

Response to argument 3. The appellant has argued that Dereume contains several deficiencies, including, a system having four separate elements, a gasket comprising two apertures, and gasket positioned at the distal end of the prosthesis. The examiner disagrees. The appellant has not claimed the elements to be separate and distinct and it is also noted even one element could be considered to meet the claim, if it had all combined features recited. Also, two apertures are clearly shown by Dereume in fig.3, 7, and 8. In addition, any portion along the conduit may be considered a distal end, depending on how one interprets the conduit to be located (how far the conduit is interpreted to extend). The appellant has also argued that Lunn fails to cure the above deficiencies and further argues that Lunn does not teach pleats that cover an entire stent, or a stent that extends the entire length of the graft. The examiner disagrees. The

appellant has not claimed a stent to extend throughout an entire length of a conduit. The appellant has only claimed a conduit including a self-expanding lattice and graft material covering at least a portion of the lattice. Nowhere in the claim is it required for the stent in combination with the graft to extend the entire length of the conduit. And nowhere in the claim is it require for the pleats to extend the entire length of the graft.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Cheryl Miller

Conferees:

Corrine McDermott

Angela Sykes

CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

ANGELA D. SYKES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

Appendix

Claim 20. The system of claim 1, wherein the compressible gasket comprises an open cell foam material.